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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/568,522

02/15/2006

Shunsuke Takaki

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10/08/2008

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EXAMINER

MCCLENDON, SANZA L

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

10/08/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/568,522	Applicant(s) TAKAKI, SHUNSUKE	
	Examiner Sanza L. McClendon	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/15/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102/35 USC § 103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takanobu (JP 2002-060456).

4. Takanobu sets forth a carboxyl containing polyurethane (meth) acrylate oligomer for use in making PSA's useful in medical applications. Said polyurethane has the structure as found in the abstract and section [0008] represented by formula I. The urethane is obtained by reaction of a random copolymer having ethylene oxide and propylene oxide units, a mono-ol containing compound, a carboxyl-groups containing polyol, an organic isocyanate, and a hydroxyalkyl (meth) acrylate compound. In section [0012] it is taught that the M moiety in formula 1 is the dehydration residue of an alkoxy

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polyethylene glycol, an alkoxy polypropylene glycol, a fatty alcohol, hydroxyl group containing (meth) acrylate and a mono-ol compound chosen from carboxyl group content monoalcohols. The P, B, I, and A moieties are described in sections [0008] to [0012]. These are deemed to anticipate claims 3 and 14. Takanobu sets forth that said polyurethane can be cured in the presence of active energy, such as UV and electron beam, as well as, heat to obtain a PSA that has excellent curability and moisture permeability. Said urethane composition can be coated onto a substrate, such as a plastic or fabric and cured to obtain a use medical article having PSA properties, as well as, moisture-permeability and low skin irritation. It is deemed that the examples anticipate the teachings of claims 4-5 and 15. Takanobu teaches that when using electron beam the need for a photoinitiator is eliminated. In addition, it is taught that reducing the photoinitiator content reduces the affect of skin irritation--see [0033]. When electron beam is used in the method applicant's limitation of less than 1.5% by weight photoinitiator is anticipated, since less than includes zero (0) percent. It is deemed that the limitation of claims 9 and 18 are taught in the reference in such a way that one of ordinary skill in the art understand that lowering the photoinitiator content increases the benefit of low skin irritability. Per the examples, Takanobu teaches using a hindered phenol-based antioxidant (di-t-butylhydroxyphenol)—see example 1.

Takanobu differs from the instant invention in that there is no teaching of the glass transition of the base polymer being 0 °C or less. The examiner deems that the polyurethane of Takanobu meets the limitations of the claims and, since, the Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether Applicant's composition differs and, if so, to what extent, from the discussed reference. Therefore, with the showing of the reference, the burden of establishing non-obviousness by objective evidence is shifted to the Applicants.

5. Regarding the plasticizers of claims 2, 6, 13, 16; it is deemed that it would have been well within the skill of an ordinary artisan to incorporate a known additive for their art recognized functions and properties within the composition of Takanobu. The motivation would have been a reasonable expectation of producing a PSA having improved properties. Wherein the courts have upheld it is obvious to add known

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ingredients to a composition for its known function--see *In re Linder*, 173 USPQ 356 and *In re Dial et al*, 140 USPQ 244. Regarding the limitation in claim 12 regarding heating the adhesive to form a coating having the defined viscosity, it is well within the skill of an ordinary artisan to use heat as a way to modify viscosity to provide a optimal coating parameters--see *In re Aller et al.*, 105 USPQ 233 (CCPA 1955) and *In re Reese*, 129 USPQ 402.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sanza L McClendon/
Primary Examiner,
Art Unit 1796

SMc

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